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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,535	08/01/2003	Avelino Corma Canos	2429-1-025	2666
7590	05/05/2005		EXAMINER	
KLAUBER & JACKSON 411 Hackensack Avenue Hackensack, NJ 07601			SAMPLE, DAVID R	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/632,535	CORMA CANOS ET AL.	
	<b>Examiner</b> David Sample	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 March 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) 1, 11-15, 23, 29, 36 and 38 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040202;20031110</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

Claims 1, 11-15, 23, 29, 36 and 38 are objected to because of the following informalities:

In claim 1, line 4, “Table l” should be -- Table I--.

In claim 1, the use of “such as” phrases is not traditionally employed in US practice. One of ordinary skill in the art can determine the metes and bounds of the invention, so a rejection under § 112, second paragraph is not appropriate. However, the examiner requests that the “such as” phrase be deleted from claim 1.

In claim 3, line 4, “pH comprised between” is not idiomatic English.

In claim 11, line 7, it appears that the text “ $H_2O/(SiO_2 + GeO_2)$ ” should start on a new line.

In claim 11, lines 7 and 9, the plus sign ‘+’ is improperly superscripted,  $(SiO_2^+GeO_2)$ , rather than being plane text,  $(SiO_2+GeO_2)$ .

In claims 12 to 15, silicon dioxide is written with a zero ( $SiO_2$ ) rather than the letter ‘O’ ( $SiO_2$ ).

Claim 23, line 4, and claim 24, line 3, refer to “alkaline” cations rather than “alkali” metal cations.

Claim 29 appears to be incomplete because the claim fails to relate the empirical formula to the remainder of the claim. It appears that the formula relates to the composition of the material obtained after roasting.

In claim 36, lines 1 and 2, “any one of claim 1” is improper.

In claim 38, line 2, “accordint” should be -- according --.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 3, recites that the material has an x-ray diffraction pattern “like” the one in Table I. The term “like” is indefinite because one of ordinary skill in the art cannot determine the scope of x-ray diffraction patterns that are similar enough to be “like” the pattern in Table I.

Claim 1 appears to be an improper process claims because no active steps are recited in the claim.

Claim 1, lines 5-8, employ a “wherein” phrase that refers to a relationship of peak intensities between the peaks at 6.9° and 9.6° and the peak at 7.6°. However, the remainder of the claim only defines an intensity relationship between the 9.6° peak and the 7.6° peak. The relationship between the 6.9° peak and the 7.6° peak is omitted from the claim.

In claim 2, line 4, the term “type” as it relates to the tetraalkylammonium cations is indefinite because one of ordinary skill in the art cannot determine the scope cations that fall within the class of ‘type’ compounds.

In claim 2, line 9, “the nitrogen atoms” lacks antecedent basis because the claim refers only to “tetraalkylammonium” cations which would have a single nitrogen atom, not plural atoms.

In claim 2, line 12, the term “some” is indefinite because it renders what follows to be meaningless.

In the following instances, the claims employ the improper Markush language “selected from among” rather than the proper phrases: “selected from the group consisting of ... and ...,” or “is ... or...”:

Claim 7, line 3;

Claim 9, line 3;

Claim 21, line 4;

Claim 31, line 1;

Claim 33, line 1; and

Claim 33, line 2.

Claim 8 does not appear to further limit claim 3 because claim 3 already positively recites that the reaction mixture contains Si and Ge. Perhaps applicants intended to recite that the reaction mixture contains a tetravalent element source in addition to SiO<sub>2</sub> and GeO<sub>2</sub>.

Claims 16-18 positively recite the inclusion of a trivalent element to the reaction mixture. However, the upper limit of the range of (Si+Ge)/X is infinity, which means that no trivalent element is present.

Similarly, claims 19-22 positively recite the inclusion of an additional tetravalent element, but include infinity as an upper limit for the (SiO+GeO<sub>2</sub>)/TO<sub>2</sub>. Therefore, the claims are indefinite as to whether the claims require the addition of the tetravalent element.

Claims 23-28 positively recite the inclusion of alkali or alkaline earth metal cations in the reaction mixture, however, the claims recite a range for M/(SiO<sub>2</sub>+GeO<sub>2</sub>) with zero as a lower

limit. If zero is the lower limit, no cations are added. Therefore, the claims are indefinite as to whether the claims require the addition of the cations.

The term "gentle" in claim 32 is a relative term which renders the claim indefinite. The term "gentle" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Claim 36 provides for the use of the material of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 9-18, 30, 34, 35, 37, 38 are rejected for failing to correct the deficiencies of the claims from which they depend.

#### ***Claim Rejections - 35 USC § 101***

Claim 36 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Double Patenting***

Claims 30-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 19-26 of copending Application No. 10/412,624.

Claim 30 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a zeolite ITQ-16 free of fluorine. Claim 1 of the '624 suggests such a product.

Claims 31-38 are taught by claims 19-26 of the '624 application.

This is a provisional obviousness-type double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

***Conclusion***

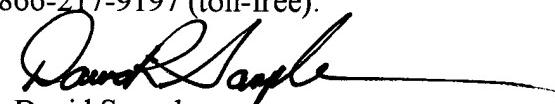
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 1755

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Sample whose telephone number is (571)272-1376. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (572)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Sample  
Primary Examiner  
Art Unit 1755